

## **REMARKS**

### **FINALITY OF THE OFFICE ACTION**

Applicants request that the finality of the Office Action be withdrawn as it is improper. The previous Office Action was found responsive; nevertheless, the Office Action was made final because allegedly applicant's amendments necessitated the new grounds of rejections.

Applicants respectfully disagree. The amendments in claims 9 and 22 changed the "comprising" language of the claims to "consisting essentially of" language. The claims were not broadened in any way. A typographical error was also corrected in claim 4, which did not change its scope. Thus, the new prior art rejections that were made in the final rejection could have been made prior to the amendments. Therefore, the amendments did not necessitate the new grounds of rejection, making the finality of the Office Action improper.

Reconsideration is requested.

### **STATUS OF CLAIM 17**

While the Office Action summary page lists claim 17 as rejected, no rejection is made with respect to claim 17 in the Office Action itself. Clarification is requested.

### **THE CLAIM OBJECTIONS**

Claim 9 is rewritten in independent form. The scope of claim 9 is not changed.

### **THE CLAIM REJECTION UNDER 35 USC § 103**

The claims were rejected over Bjornson in view of Sudhakar and/or Bijwaard as allegedly unpatentable. Applicants respectfully disagree.

Bjornson, as recognized by the Office Action, does not teach that the disclosed catalysts are or should be modified by a promoter selected from phosphorus, boron (the Office Action refers to bismuth which is believed to be a typographical error) or halogen. Instead the reference teaches that the catalysts should be impregnated with a promoter such as Ni, Co, Mo and/or Re which are generally in the form of oxides or as oxides and sulfides if the catalyst is presulfided. See column 2, lines 30-35, and lines 45-50. Nowhere does the reference teach or suggest that

additional or other promoters may be used. Instead the reference only teaches that "suitable compounds of Mo, Ni and/or Co and Re can be used. See column 2, lines 62-63.

As the Examiner is aware, the motivation to combine the teachings of prior art references must come from the prior art, usually the references themselves. It is not enough that each element of an invention can be found in the prior art. See *In re Laskowski*, 871 F.2d 115, 10 USPQ2d 1397 (Fed. Cir. 1989). In the present case, the primary reference appears to teach only promoters Ni, Co, Mo and/or Re without teaching or suggesting that other conventional promoters may be added to the catalyst in combination with the promoters already present.

Additionally, the catalysts of Bjornson require the presence of zinc titanate. See column 1, lines 53-58. The "consisting of" language in claims 23, 25 and 26 excludes the zinc component of Bjornson. No teaching or suggestion is made in any of the references that the zinc titanate component of the Bjornson reference may be excluded.

Both the Sudhakar and the Bijwaard references teach that the catalyst disclosed therein may contain promoters such as halogen, phosphorus or boron. No teaching or suggestion is made therein to modify a catalyst that contains Rhenium. Thus, one of ordinary skill in the art would have lacked the motivation to use these promoters on catalysts already promoted by Rhenium.

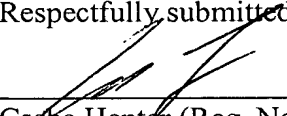
Thus, the claims are patentable.

Even though not necessary to establish patentability of the claimed invention, applicants submit a Declaration which establishes unexpected results for a catalyst containing both Rhenium and Phosphorus compared to a catalyst that contains only either Rhenium or Phosphorus. The catalysts containing either Phosphorus or Rhenium have similar activities, i.e., 1 and 1.17 relative activities, respectively, while the catalyst containing both promoters more than doubles in activity over either catalyst containing only one of the promoters, i.e., 2.79 relative activity. One of ordinary skill in the art would not have expected such an increase in activity which is therefore unexpected and which is also significant.

Reconsideration is respectfully requested.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,



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Csaba Henter (Reg. No. 50,908)  
Richard J. Traverso (Reg. No. 30,595)  
Attorneys for Applicant(s)

MILLEN, WHITE, ZELANO  
& BRANIGAN, P.C.  
Arlington Courthouse Plaza 1, Suite 1400  
2200 Clarendon Boulevard  
Arlington, Virginia 22201  
Telephone: (703) 243-6333  
Facsimile: (703) 243-6410

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